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09/391-762

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY-DOCKET NO.
09/391,762	09/08/99	WEADOCK	49205 REC

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PRELIMINARY EXAMINER
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3745	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/391,762

Applicant(s)

Weadock et al

Examiner

Paul Prebilic

Group Art Unit

3738



☒ Responsive to communication(s) filed on Aug 14, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-18 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-18 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### DETAILED ACTION

Applicant is reminded of his responsibility to notify the USPTO of any litigation pertaining to this reissue application.

The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Claims 13-18 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Present claims 13-18 are improper for a reissue application because they attempt to recapture subject matter surrendered in order to overcome a prior art rejection. Specifically, during the pendency of the patented file 08/289,790, the language "filled with fluid which solidifies and is crosslinked to form" and "said material being insoluble at a pH of about 7.4" was

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added in order to overcome a prior art rejection. Therefore, it is improper to attempt to recapture this subject matter via claims 13-18 in the present reissue application.

***Claim Objections***

Claim 17 is objected to because of the following informalities:

The language "said chemical solution" lacks antecedence. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 13 is rejected under 35 U.S.C. 102(e) as being anticipated by Jernberg (US 5,290,271), or alternatively under 35 U.S.C. 103(a) as being unpatentable over Jernberg (US 5,290,271) alone. Jernberg anticipates the claim language wherein the microparticles are the precipitated composition as claimed since they are precipitated out of a fluid suspension onto and into the expanded polytetrafluoroethylene substrate; see the entire document. Precipitation can be simply a removing of suspended solid particles out of liquid suspension of those particles, and thus, the claim language is fully met with this interpretation.

Alternatively, since the process limitations are not explicitly set forth in Jernberg, one could interpret the claim as not being fully met. However, since it appears that at least a substantially identical product is produced thereby, it is the Examiner's position that the claimed product is at least clearly obvious over Jernberg alone; see MPEP 2113 which is incorporated into this rejection by reference thereto.

Claims 1-8 and 11-18 are rejected under 35 U.S.C. 102(b) as anticipated by Tran et al (article entitled "Plasma Modification . . . ") or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tran et al (article entitled "Plasma Modification . . . ") in view of Okita (US 4,193,138). Tran et al (article) anticipates the claim language wherein GORTEX grafts are synonymous with expanded polytetrafluoroethylene grafts which have node and fibrils as claimed. The collagen is precipitated out of the Vitrogen solution as a suspension onto the graft substrate at a particular pH and temperature such that the crosslinking reaction can take place; see the entire document.

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Alternatively, one may not consider Tran et al (article) an anticipating patent because it does not explicitly disclose the fibril and node structure as set forth in the present claims.

However, the Okita teaches that such fibril and node structure is known to the same art and indirectly that GORTEx is an expanded polytetrafluoroethylene material with nodes and fibrils; see the entire document, especially the figures and column 1, lines 26-41. Hence, it is the Examiner's position that it would have been obvious to use the graft of Okita as the substrate of Tran et al for the same reasons that Okita uses the same in the invention thereof and so that an impregnable substrate material can be used as a better means to hold the collagen to the graft.

Claims 1-10 and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman Jr. et al (US 5,197,977) in view of Okita et al (US 4,193,138). Hoffman Jr. et al meets the claim language by disclosing a vascular graft which is sealed by a precipitate of collagen and solidified by crosslinking but fails to disclose the expanded PTFE substrate as claimed; see the entire document. Okita, however, teaches that it was known to the art to use expanded PTFE as a substrate or implant material in order to provide an inert graft material; see the entire document. Hence, it is the Examiner's position that it would have been obvious to use the Okita base material or substrate as the substrate of Hoffman, Jr. et al so that the inert and advantageous properties envisioned by Okita can be utilized in the Hoffman, Jr. et al invention.

Claims 1-8, 11, and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alonso (US 5,037,377) in view of Okita (US 4,193,138). Alonso discloses many types of porous substrates for use therewith but fails to disclose the use of expanded PTFE, which inherently has

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the node and fibril structure recited in claims 1 and 13, as the substrate material; it is noted that soluble collagen of Alonso is made insoluble by crosslinking it and that it is insoluble at a 7.4 pH because 7.4 is the pH of the crosslinking solution and the crosslinking solution does not dissolve the collagen material; see the entire document. Okita, however, teaches that it was known to use expanded PTFE as a substrate and graft material in order to provide an inert graft material; see the entire document. Hence, it is the Examiner's position that it would have been obvious to use the Okita base material or substrate for the base or substrate of Alonso so that inert and advantageous properties envisioned by Okita can be utilized in the Alonso invention.

### ***Response to Arguments***

Applicant's arguments filed August 14, 2000 have been fully considered but they are not persuasive.

In response to the traversal of the 35 USC 251 rejection that it a patentee is free acquire claims of narrower scope than original canceled claims, the Examiner respectfully disagrees and takes the position that patentee is only free to obtain claims of narrower scope than the allowed claims of the original patent. Since original claim 1 was not allowed, recapture of the subject matter thereof is not allowed. Rather, present claims 13-18 attempt to recapture subject matter surrendered by amending original claim 1 to overcome a prior art rejection; see MPEP 1412.02. Particularly, in a review of the file of serial number 08/289,790, it is clear that claim 1 was amended to overcome a prior art rejection. The interview summary record dated February 27,

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1997 (Paper No. 17) which put the application in condition for allowance states **“Agreed on language that distinguishes over Jernberg and the other arts of record. Claim 1 has been amended to include allowable language.”**.

The amendments to claim 1 on February 27, 1997 were as follows:

In claim 1, on line 6, the language ----filled with fluid which solidifies and is crosslinked to form---- was inserted after “pores” and the word “containing” was deleted on this same line.

In claim 1, on line 6, after “solid”, ---precipitate of a--- was inserted.

In claim 1, on line 8, after “origin”, ----said material being insoluble at a pH of about 7.4---- was inserted.

Since claim 13 leaves out most of the language of these three limitations, it is broader in scope than allowed claim 1 and attempts to recapture surrendered subject matter.

In response to the traversal stating that the *Whittaker Corp. v. UNR Industries, Inc.* decision allowed reissue claims broader in certain aspects but narrower in others, the Examiner respectfully disagrees and takes the position that this case only decided one issue, that is, whether the reissue patent claims differ materially from the claims that were surrendered to obtain the original patent; see page 1744 of the decision. It is not seen, in this decision, where reissue claims can be broadened and still avoid the recapture doctrine. Nonetheless, that is not the particular issue here where patentee clearly surrendered subject matter and is attempting to recapture that same subject matter in this reissue application.



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In response to the traversals of the Hoffman Jr. et al in view of Herweck et al and the Alonso in view of Herweck et al rejections, the Examiner has changed the grounds of rejection with this office action such that the arguments directed thereto are irrelevant.

In response to the traversal of the Jernberg rejection that a precipitate within the pores at selected conditions for cellular attachment is not produced, the Examiner respectfully disagrees. Jernberg, as stated in the altered rejection, discloses that the microparticles, which are the precipitated composition as claimed, are precipitated out of a fluid suspension onto and into the expanded polytetrafluoroethylene substrate; see the entire document. Precipitation can be simply a removing of suspended solid particles out of liquid suspension of those particles, and thus, the claim language is fully met with this interpretation. Furthermore, this process, to the extent it can be given weight in a product claim (see MPEP 2113), is done at a pH and temperature which allows it to be done. Thus, the claim language in that regard is met. In addition, since the graft with microparticles, would not prevent cellular attachment, it also would function to be a site for cellular attachment to the extent that this language can be given weight. For these reasons, claim 13 is fully met by Jernberg such that the rejection thereon is maintained.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilio whose telephone number is (703) 308-2905. The examiner normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached on (703) 308-1065. The fax phone number for this Technology Center is (703) 305-3580.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.

A handwritten signature in black ink, appearing to read "Paul Prebilic". The signature is fluid and cursive, with a long horizontal stroke at the end.

Paul Prebilic  
Primary Examiner  
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